

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 200312102-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Radha Sen et al.

Confirmation No.: 9177

Application No.: 10/789,963

Examiner: YOON, Tae H.

Filing Date: February 27, 2004

Group Art Unit: 1796

Title: A System and Method for Forming a Heat Fusible Microporous Ink Receptive Coating

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on April 29, 2008.

☐ The fee for filing this Appeal Brief is \$510.00 (37 CFR 41.20).

☒ No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$460

☐ 3rd Month
\$1050

☐ 4th Month
\$1640

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

Radha Sen et al.

By /Steven L. Nichols/

Steven L. Nichols

Attorney/Agent for Applicant(s)

Reg No. : 40,326

Date : September 30, 2008

Telephone : 801-572-8066

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of

Radha Sen et al.

Application No. 10/789,963

Filed: February 27, 2004

For: A System and a Method for Forming
a Heat Fusible Microporous Ink
Receptive Coating

Group Art Unit: 1796

Examiner: YOON, Tae H.

Confirmation No.: 9177

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal Brief under Rule 41.37 appealing the decision of the Primary Examiner dated March 6, 2008 (the “final Office Action”). Each of the topics required by Rule 41.37 is presented herewith and is labeled appropriately.

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no appeals or interferences related to the present application of which the Appellant is aware.

III. Status of Claims

Claims 26-45 and 59-70 were withdrawn from consideration under a previous Restriction Requirement and cancelled without prejudice or disclaimer. Claims 1-25, 46, 47, 50, 54 and 73-79 were also cancelled previously without prejudice or disclaimer.

Thus, claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 are currently pending in the application and stand finally rejected. Accordingly, Appellant appeals from the final rejection of claims 48, 49, 51-53, 55-58, 71, 72 and 80-90, which claims are presented in the Appendix.

IV. Status of Amendments

No amendments have been filed subsequent to the final Office Action of March 6, 2008, from which Appellant takes this appeal.

V. Summary of Claimed Subject Matter

Appellants' sole independent claim recites the following:

48. A print medium having a microporous coating comprising:

a substrate (112) which serves as a base of said print medium (*Appellant's specification, paragraph 0018*);

a first microporous layer (114) comprising a first binder deposited as a liquid on said substrate (*Appellant's specification, Fig. 1 and paragraphs 0018 and 21*); and

a fusible latex layer (150) deposited over said first microporous layer (114) (*Appellant's specification, Fig. 1 and paragraph 0021*), wherein said fusible latex layer (150) is microporous and includes particles comprising a hard core material and a soft shell material (*Appellant's specification, paragraph 0021*);

wherein said latex (150) exhibits self-adhesive properties at a room temperature such that said latex layer (150) remains in place on said first microporous layer (114) without requiring a second binder and without being fused (*Appellant's specification, paragraphs 0004 and 0026*).

VI. Grounds of Rejection to be Reviewed on Appeal

The final Office Action raised the following grounds of rejection.

(1) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

(2) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

(3) Claims 48, 49, 51-53, 55, 57, 58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 102(e) as anticipated by of U.S. Patent No. 7,086,732 to Kasperchik et al. (“Kasperchik”).

(4) Claims 48, 49, 51-53, 55, 57, 58, 71, 72, 80 and 86-89 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasperchik, taken alone.

According, Appellant hereby requests review of each of these grounds of rejection in the present appeal.

VII. Argument

(1) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 comply with the written description requirement of 35 U.S.C. § 112, first paragraph:

According to the final Office Action, the claims are not supported by a written description in the specification as originally filed “since newly recited ‘deposited as a liquid on [said] substrate’ does not have support in [the] originally filed specification. Appellant points to PP 0021, but the examiner does not see any support for the amendment” to the claims. (final Office Action, p. 2). Appellant respectfully disagrees.

As an initial matter, Appellant would like to point out that a “written description” in the specification supporting a particular claim need *not* be a verbatim recitation of the claim language. Rather, as explained in MPEP § 2163.02, the necessary written description can be provided “using such descriptive means as words, structures, figures, diagrams, and formulas.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

In the present application, claim 48 recites:

A print medium having a microporous coating comprising:
a substrate which serves as a base of said print medium;
a first microporous layer comprising a first binder *deposited as a liquid on said substrate*; and

a fusible latex layer deposited over said first microporous layer, wherein said fusible latex layer is microporous and includes particles comprising a hard core material and a soft shell material;

wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.

(Emphasis added).

The subject matter at issue in this rejection is highlighted in claim 48 above. This subject matter is supported in Appellant’s originally filed application as follows.

Firstly, Fig. 1 clearly shows the microporous layer (114) being deposited as a liquid on a substrate (112). This alone is adequate written description supporting claim 48.

Additionally, Appellant's specification, as pointed out to the Examiner previously, states the following.

[0021] The ink receptive medium (110) illustrated in Figure 1 is configured to receive a hard core/soft shell latex coating and a recording agent. As shown in Figure 1, the ink receptive medium (110) may include, but is in no way limited to a photo or film base (112) having a microporous substrate (114) disposed thereon. According to one exemplary embodiment, the photo or film base (112) may include any photo base or paper base material. Additionally, according to one exemplary embodiment, the present hard core/soft shell latex coating may be coated on a previously coated latex lattice. As shown in Figure 1, a microporous substrate (114) is disposed on the photo or film base (112) immediately preceding the deposition of the hard core/soft shell latex (150), according to a wet on wet configuration. The microporous substrate (114) may be any material configured to receive a recording agent including, but in no way limited to, a microporous inorganic composition such as fumed silica, colloidal silica, fumed aluminum, or colloidal aluminum; calcium carbonate; polymeric membrane; a plastic pigment; or a previously coated latex lattice.
(Appellant's specification, paragraph 0021) (emphasis added).

Thus, paragraph 0021 clearly states that the microporous substrate and latex are deposited sequentially "according to a wet on wet configuration," i.e., both are deposited in wet, liquid form. One of ordinary skill in this art would clearly understand that a wet on wet deposition, which is a term of art, refers to sequential deposition in liquid form. Consequently, claim 21 also gives the necessary written description in the original specification for the recitation in claim 48 of "a first microporous layer comprising a first binder *deposited as a liquid on said substrate.*" (Emphasis added).

Therefore, the rejection of Appellant's claims under 35 U.S.C. § 112, first paragraph, should not be sustained.

(2) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 comply with 35 U.S.C. § 112, second paragraph:

The final Office Action mentions a number of reasons for objecting to the claims under § 112, second paragraph. None of these reasons have any merit and some do not even properly allege an instance of indefiniteness under § 112.

(1) The final Office Action argues that “[i]t is unclear whether said deposited liquid stays as a liquid or not on said substrate, and thus claims are indefinite.” (final Office Action, p. 3). It is entirely unclear how this creates any indefiniteness.

As noted above, claim 48 recites “a first microporous layer comprising a first binder deposited as a liquid on said substrate.” Thus, if the first microporous layer is deposited as a liquid, it reads on that portion of claim 48. Whether the layer then stays indefinitely in liquid form is not addressed by, or at issue, with respect to claim 48. Therefore, this particular objection raised by the Examiner is entirely without merit and is *not* an instance of indefiniteness. Consequently, this portion of the rejection under 35 U.S.C. § 112, second paragraph, should not be sustained.

(2) The final Office Action next argues that “[t]he recited preamble, ‘The microporous coating of ---’, in claims 49, 50-53, 55-58, 71, 72 and 80-90 lack a proper antecedent basis in claim 48 wherein ‘A print medium’ is claimed now.” (final Office Action, p. 3). In response, Appellant notes that the Examiner has failed to accurately and completely quote the preamble of claim 48. Claim 48 recites: “A print medium having *a microporous coating* comprising” (Emphasis added). Thus, claim 48 clearly provides antecedent basis for the dependent claims which specify further details of the “microporous coating” recited in claim 48. Consequently, this portion of the rejection under 35 U.S.C. § 112, second paragraph, should not be sustained.

(3) The final Office Action next argues that “[c]laims 81-84 are confusing and indefinite since they recited polymers (such as polystyrene) for a core material and monomers (such as n-ethylhexylacrylate) for a shell material. Consistency is needed.” (final Office Action, p. 3). This position is unreasonable on its face. Appellant is unaware of any rule that prohibits reciting different types of materials for different components of a composition. Moreover, Appellant fails to see how the claims are in any way inconsistent. Thus, the basis for the Examiner’s rejection here is entirely unclear. However, there clearly is no indefiniteness with respect to the rejected claims. Consequently, this portion of the rejection under 35 U.S.C. § 112, second paragraph, should not be sustained.

(4) Finally, the final Office Action argues that the “recited ‘said shell material comprises a coalescing agent’ in claim 90 is confusing and indefinite since said coalescing agent is a solvent as taught by Kasperchik ... and a solvent cannot form a shell.” (final Office Action, p. 3). Again, this position is unreasonable and entirely without merit.

Appellant does not believe that the cited prior art to Kasperchik requires that a coalescing agent must be a solvent. However, whatever the prior art may say on this subject is largely irrelevant as Appellant has the right to define “coalescing agent” for purposes of the present application and claims. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 888-89, 221 U.S.P.Q. 1025 (Fed. Cir. 1984). Appellant’s specification defines a coalescing agent as an agent that is able to “effectively lower the Tg of the shell for soft shells having a higher than process temperature Tg.” (Appellant’s specification, paragraph 0041). Appellant’s specification then gives specific examples of the claimed coalescing agent. (*Id.*).

This definition for Appellant’s specification informs the recitation of a “coalescing agent” in the claims. Therefore, the allegation of indefiniteness with respect to claim 90 is

entirely without merit. Consequently, this portion of the rejection under 35 U.S.C. § 112, second paragraph, should not be sustained.

(3) Claims 48, 49, 51-53, 55, 57, 58, 71, 72 and 80-90 are not anticipated by Kasperchik:

Claim 48:

In the present application, claim 48 recites:

A print medium having a microporous coating comprising:
a substrate which serves as a base of said print medium;
a first microporous layer comprising a first binder deposited as a liquid on said substrate; and
a fusible latex layer deposited over said first microporous layer, wherein said fusible latex layer is microporous and includes particles comprising a hard core material and a soft shell material;
wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.

(Emphasis added).

In contrast to claim 48, the final Office Action does not indicate how or where Kasperchik teaches the claimed “first microporous layer comprising a first binder deposited as a liquid on said substrate.” It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this reason, the rejection of claim 48 and its dependent claims should not be sustained.

Additionally, Kasperchik does not appear to anticipate the claimed fusible latex layer “wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.” The final Office Action equates the claimed fusible latex layer with a “color-receiving layer 8” taught by Kaspercik. (final Office Action, p. 4.).

However, in direct contrast to independent claim 48, Kasperchik teaches that the color-receiving layer may include a binder. According to Kasperchik,

The colorant-receiving layer 8 may also include a small amount of polymer binder to bind the core-shell polymer particles 10 into a layer. The polymer binder in the colorant-receiving layer 8 may be one of the polymer binder materials described above for use in the vehicle sink layer 6. For instance, the polymer binder may be a water-soluble or water-dispersible polymer such as gelatin, polyvinyl pyrrolidone, a water-soluble cellulose derivative, polyvinyl alcohol or its derivatives, polyacrylamide, polyacrylic acid, or a water-soluble acrylic acid co-polymer. Preferably, the polymer binder of the colorant-receiving layer 8 is polyvinyl alcohol or a water-soluble or water-dispersible derivative thereof. The amount of polymer binder present in the colorant-receiving layer 8 may be sufficient to bind the core-shell polymer particles together without blocking the pores between the core-shell polymer particles 10. (Kasperchik, col. 6, lines 49-64).

Thus, Kasperchik does not appear to anticipate the claimed subject matter in which “said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer *without requiring a second binder and without being fused.*” (Emphasis added). To the contrary, Kasperchik teaches away from the claimed subject matter by expressly stating that a polymer binder may be used, giving examples of the binder and describing the amount of binder to be used.

Nevertheless, the final Office Action interprets Kasperchik as teaching that the use of the binder in the colorant-receiving is optional. Consequently, the Office Action reads into Kasperchik a teaching of a color-receiving layer that does not include any binder. Appellant questions whether the casual use of the words “may include” actually anticipates embodiments that *do not include* the binder.

In any event, claim 48 does not merely recite latex layer that does not include a binder. Rather, claim 48 recites a latex layer that “exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without

requiring a second binder and without being fused.” (Claim 48). The final Office Action has cited no such teaching or suggestion in Kasperchik.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Moreover, MPEP 2131 further states: "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). For at least these reasons, there is no anticipation of claim 48 under § 102, and the rejection based on Kasperchik should not be sustained.

Claim 49:

Claim 49 recites: "The microporous coating of claim 48, wherein said latex layer is ink permeable and permits the transmission of ink through said latex layer to said first microporous layer prior to said fusible latex layer being fused." In contrast, Kasperchik described its latex "colorant-receiving layer" as only passing an ink vehicle while capturing the colorant of the ink.

According to Kaspercik, "the ink vehicle passes through the colorant-receiving layer 8 and into the vehicle sink layer 6, while the colorant remains in the colorant-receiving layer 8." (Kasperchik, col. 4, lines 43-46). Therefore, the colorant-receiving layer 8 is not "ink permeable" as recited in claim 49. For at least this additional reason, the rejection of claim 49 should not be sustained.

Claim 52:

Claim 52 recites: “The microporous coating of claim 51, wherein said hard core material exhibits a glass transition temperature above 80 degrees Celsius and said soft shell material exhibits a glass transition temperature below 70 degrees Celsius.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 52 should not be sustained.

Claim 55:

Claim 55 recites: “The microporous coating of claim 52, wherein said soft shell material comprises a cationic monomer or a salt of a cationic monomer.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 55 should not be sustained.

Claim 57:

Claim 57 recites: “The microporous coating of claim 49, wherein said latex further comprises a coalescing agent.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 57 should not be sustained.

Claim 80:

Claim 80 recites: “The microporous coating of claim 48, wherein core material comprises more than 50% by weight of said particles.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 80 should not be sustained.

Claim 81:

Claim 81 recites: “The microporous coating of claim 48, wherein core material comprises polystyrene and is 50% by weight of said particles, and said shell material comprises n-ethylhexylacrylate that is 40% by weight of said particles and 2-

hydroxyethylacrylate that is 10% by weight of said particles.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 81 should not be sustained.

Claim 82:

Claim 82 recites: “The microporous coating of claim 48, wherein core material comprises polystyrene and is 70% by weight of said particles, and said shell material comprises ethoxyethylacrylate and is 30% by weight.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 82 should not be sustained.

Claim 83:

Claim 83 recites: “The microporous coating of claim 48, wherein core material comprises Polymethylmethacrylate and is 70% by weight of said particles, and said shell material comprises 2-hydroxyethylacrylate and is 30% by weight.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 83 should not be sustained.

Claim 84:

Claim 84 recites: “The microporous coating of claim 48, wherein core material comprises polystyrene and is 40% by weight of said particles, and said shell material comprises n-ethylhexylacrylate that is 40% by weight of said particles and 2-hydroxyethylacrylate that is 20% by weight of said particles.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 84 should not be sustained.

Claim 85:

Claim 85 recites: “The microporous coating of claim 48, wherein said first microporous layer comprises aluminum.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the

Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 85 should not be sustained.

Claim 86:

Claim 86 recites: "The microporous coating of claim 48, wherein said particles are smaller than 200 nm." According to the final Office Action, this subject matter is inherent in the teachings of Kasperchik. (final Office Action, p. 4).

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (citations omitted). "[T]he examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis in original); see also, MPEP § 2112 (quoting *Levy*).

In the present case, the Examiner has failed to meet this burden of showing that the subject matter of claim 86 is inherent in the cited prior art. Consequently, the rejection of claim 86 should not be sustained.

Claim 87:

Claim 87 recites: “The microporous coating of claim 48, wherein said shell material has a Tg from above 20 ° C up to 70° C.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 87 should not be sustained.

Claim 88:

Claim 88 recites: “The microporous coating of claim 48, wherein said fusible latex layer is coating at 1 to 2 grams per square meter on said first microporous layer.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 88 should not be sustained.

Claim 89:

Claim 89 recites: “The microporous coating of claim 48, wherein said first microporous layer is 10 to 50 grams per square meter and said fusible latex layer is 0.1 to 10

grams per square meter.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 89 should not be sustained.

Claim 90:

Claim 90 recites: “The microporous coating of claim 48, wherein said shell material comprises a coalescing agent that lowers the Tg of a shell of said particles.” The final Office Action fails to indicate how or where the prior art anticipates this subject matter.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this additional reason, the rejection of claim 90 should not be sustained.

(4) Claims 48, 49, 51-53, 55, 57, 58, 71, 72, 80 and 86-89 are not obvious over

Kasperchik:

This rejection must fail under 35 U.S.C. § 103(c). 35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Appellant notes that Kasperchik is available as prior art against the present application only under 35 U.S.C. § 102(e). The Office also recognizes this fact as Kasperchik was applied by the outstanding Office Action under § 102(e) in the previous rejection addressed above. (final Office Action, p. 4). Appellant also notes that Kasperchik is assigned to the Hewlett-Packard Development Co. LP. (*See*, recorded assignment at reel/frame 014613/0988)

Similarly, the present application is also assigned to Hewlett-Packard Development Co. LP (*See*, recorded assignment at reel/frame 015115/0918).

Consequently, under 35 U.S.C. § 103(c), the Kasperchik reference *cannot* be applied as prior art against the present application under 35 U.S.C. § 103(a). Therefore, the listed rejections of claims 35-39, 49 and 50, which apply Kasperchik under § 103(a), cannot be sustained.

In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Rejection of March 6, 2008 is respectfully requested.

Respectfully submitted,

DATE: September 30, 2008

/Steven L. Nichols/

Steven L. Nichols

Registration No. 40,326

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095
(801) 572-8066
(801) 572-7666 (fax)

VIII. CLAIMS APPENDIX

1-47. (cancelled)

48. (previously presented) A print medium having a microporous coating comprising:

a substrate which serves as a base of said print medium;

a first microporous layer comprising a first binder deposited as a liquid on said substrate; and

a fusible latex layer deposited over said first microporous layer, wherein said fusible latex layer is microporous and includes particles comprising a hard core material and a soft shell material;

wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.

49. (previously presented) The microporous coating of claim 48, wherein said latex layer is ink permeable and permits the transmission of ink through said latex layer to said first microporous layer prior to said fusible latex layer being fused.

50. (cancelled)

51. (previously presented) The microporous coating of claim 49, wherein, after a printing process in which ink has passed through said latex layer, said latex is for forming a fused, continuous transparent film by the application of thermal energy or pressure.

52. (original) The microporous coating of claim 51, wherein said hard core material exhibits a glass transition temperature above 80 degrees Celsius and said soft shell material exhibits a glass transition temperature below 70 degrees Celsius.

53. (original) The microporous coating of claim 52, wherein said hard core material comprises one of poly(methylmethacrylate), poly(styrene), poly(p-methylstyrene), poly(t-butylacrylamide), poly(styrene-co-methylmethacrylate), poly(styrene-co-t-butylacrylamide), poly(methylmethacrylate-co-t-butylacrylamide), or homopolymers derived from p-cyanophenyl methacrylate, pentachlorophenyl acrylate, methacrylonitrile, isobornyl methacrylate, phenyl methacrylate, acrylonitrile, isobornyl acrylate, p-cyanophenyl acrylate, 2-chloroethyl acrylate, 2-chloroethyl methacrylate, 2-naphthyl acrylate, n-isopropyl acrylamide, 1-fluoromethyl methacrylate, isopropyl methacrylate, or 2-hydroxypropyl methacrylate.

54. (cancelled)

55. (original) The microporous coating of claim 52, wherein said soft shell material comprises a cationic monomer or a salt of a cationic monomer.

56. (original) The microporous coating of claim 55, wherein said soft shell material comprises one of poly(n-butyl acrylate co-trimethylammoniummethyl acrylate), poly(2-ethylhexyl acrylate co-trimethylammoniummethyl acrylate) poly(methoxyethylacrylate co-trimethylammoniummethyl acrylate), poly(ethoxy-ethylacrylate co-trimethylammoniummethyl acrylate), poly(n-butylacrylate-co-trimethylammoniummethyl acrylate), poly(n-butylacrylate-co-trimethylammoniummethyl methacrylate), poly(n-butylacrylate-co-vinylbenzyltrimethylammonium chloride), poly (n-ethylhexylacrylate-co-2-hydroxyethylacrylate co-trimethylammoniummethyl acrylate), poly (n-butylacrylate-co-2-hydroxyethylacrylate co-trimethylammoniummethyl acrylate), poly(n-ethylhexylacrylate -co-vinylbenzyltrimethylammonium chloride), poly(n-methoxyethylacrylate -co-vinylbenzyltrimethylammonium chloride), or poly(n-ethoxyethylacrylate -co-vinylbenzyltrimethylammonium chloride).

57. (original) The microporous coating of claim 49, wherein said latex further comprises a coalescing agent.

58. (previously presented) The microporous coating of claim 57, wherein said coalescing agent comprises one of ethylene glycol, propylene glycol, hexylene glycol, ester of ethylene glycol, propylene glycol, hexylene glycol, 2-butoxyethanol, 2,2,4-trimethylpentane diol monoisobutyrate, diisobutyl esters of a mixture of diacids, butyl cellulose, 2-(2-butoxyethoxy)ethanol, 2-butoxyethanol, diisobutyl succinate, diisobutyl glutarate, diisobutyl adipate.

59-70. (cancelled)

71. (previously presented) The microporous coating of claim 52, wherein said soft shell material comprises one of a homo- or copolymer derived from n-butyl acrylate, n-ethylacrylate, 2-ethylhexylacrylate, methoxyethylacrylate, methoxyethoxy-ethylacrylate, ethoxyethylacrylate, ethoxyethoxyethylacrylate, 2-ethylhexyl-methacrylate, n-propylacrylate, hydroxyethylacrylate, tetrahydrofurfuryl acrylate, cyclohexylacrylate, iso-decylacrylate, n-decylmethacrylate, n-propylacrylate, vinylacetate, 2-(N,N-Dimethylamino)ethyl methacrylate, 2-N-Morpholinoethyl acrylate, or 3-Dimethylaminoneopentyl acrylate.

72. (previously presented) The microporous coating of claim 52, wherein said soft shell material comprises one of tetrahydrofurfuryl acrylate, cyclohexylacrylate, iso-decylacrylate, n-decylmethacrylate, vinylacetate, 2-(N,N-Dimethylamino)ethyl methacrylate, 2-N-Morpholinoethyl acrylate, or 3-Dimethylaminoneopentyl acrylate.

73-79. (cancelled)

80. (previously presented) The microporous coating of claim 48, wherein core material comprises more than 50% by weight of said particles.

81. (previously presented) The microporous coating of claim 48, wherein core material comprises polystyrene and is 50% by weight of said particles, and said shell material comprises n-ethylhexylacrylate that is 40% by weight of said particles and 2-hydroxyethylacrylate that is 10% by weight of said particles.

82. (previously presented) The microporous coating of claim 48, wherein core material comprises polystyrene and is 70% by weight of said particles, and said shell material comprises ethoxyethylacrylate and is 30% by weight.

83. (previously presented) The microporous coating of claim 48, wherein core material comprises Polymethylmethacrylate and is 70% by weight of said particles, and said shell material comprises 2-hydroxyethylacrylate and is 30% by weight.

84. (previously presented) The microporous coating of claim 48, wherein core material comprises polystyrene and is 40% by weight of said particles, and said shell material comprises n-ethylhexylacrylate that is 40% by weight of said particles and 2-hydroxyethylacrylate that is 20% by weight of said particles.

85. (previously presented) The microporous coating of claim 48, wherein said first microporous layer comprises aluminum.

86. (previously presented) The microporous coating of claim 48, wherein said particles are smaller than 200 nm.

87. (previously presented) The microporous coating of claim 48, wherein said shell material has a Tg from above 20 ° C up to 70° C.

88. (previously presented) The microporous coating of claim 48, wherein said fusible latex layer is coating at 1 to 2 grams per square meter on said first microporous layer.

89. (previously presented) The microporous coating of claim 48, wherein said first microporous layer is 10 to 50 grams per square meter and said fusible latex layer is 0.1 to 10 grams per square meter.

90. (previously presented) The microporous coating of claim 48, wherein said shell material comprises a coalescing agent that lowers the Tg of a shell of said particles.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None

XI. Certificate of Service

None